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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/004,017	10/18/2001	Kenneth Allan Perrie	1482/187(d)	6405
23381	7590	06/15/2004	EXAMINER	
DORR CARSON SLOAN & BIRNEY, PC			HARRISON, JESSICA	
3010 EAST 6TH AVENUE			ART UNIT	PAPER NUMBER
DENVER, CO 80206			3714	//
DATE MAILED: 06/15/2004				

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

10/004,017

Applicant(s)

PERRIE ET AL.

Examiner

Jessica J. Harrison

Art Unit

3714

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 26 November 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 36-58 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 36-58 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 21 October 2001 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                   | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)             |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____  |

**DETAILED ACTION**

Acknowledgement is made of applicant's response dated November 26, 2003 and entered into the file on June 9, 2004. The delay in matching paper to file is regretted. The application has been restored to pending status.

Claims 36, 41, 52 and 55 have been amended.

***Claim Rejections - 35 USC § 112***

Claims 36 – 40 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. There is a lack of antecedent basis for “the casino bonus game” as only a casino game has been defined within the claim. Given that the invention involves two games, clear distinction between the primary or underlying game and the bonus game is necessary to delineate which game applicant is claiming.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 36- 58 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cork in view of Muzaffar et al. (GB 2271262- of record), hereinafter Muza.

Cork discloses a strategy-based casino bonus game method for a player of a gaming machine (page 8, first paragraph) which is entered from an underlying fruit machine game. The player has at most a given number of player inputs (position selections) in that the player selects positions for the ball (page 8, 4<sup>th</sup> para). The player is awarded for each successful bonus game result during play of the game (each iteration of the game as target area is expanded and compared to player input results in appropriate awards (page 6 last para – page 7 ), the game ends when the given number of player inputs have occurred without obtaining an overall game solution(as well as with overall solution) and awarding the player based on the number of player inputs used to obtain the solution (closer “X’s” get higher awards- more than one “X” in circle increases award).

Muza discloses an analogous strategy based “spot the ball” type game wherein once a player selects a position, a reveal is made to see if the player is correct. On page 4, Muza teaches ‘Depending upon the embodiment of this invention, the player may be able to make one or several selections on one or several screens and may then progress to levels of the game possibly including other skill competitions or the like, or progressing to another game within the machine. This clearly suggests a game comprising multiple rounds or levels such that a player makes an input, a reveal is made, and player makes an

input, a reveal is made, and so on. Moza is suggesting the addition of levels to make the game more interesting to a player. Also note that Moza explicitly states that which is implicit in Cork and applies to 'spot-the ball' type games in that they are strategy or skill based games rather than chance games. Moza, on page 2, second paragraph states "when the player comes to choose the point or area where the ball is missing on the static frame he is using his memory of the moving sequence in order to make his choice and not merely guessing at its possible position."

Regarding claims 36, 41 and 44 Cork fails to clearly state language of "compound hidden image" as set forth in the claims; Cork merely states the image is a ball. It is noted that Cork is illustrated with the game of (British) "football" which is also known as soccer. While not illustrated, it is commonly known that a soccer ball has two color areas – black and white, and that the image of the ball would be larger than a single pixel on the display screen. It obviously follows, therefore, that any representation of a soccer ball in Cork would be a "compound hidden image" when hidden in that it would be a number of patterns (black and white pixels) arranged and hidden from view. This is how the examiner interprets Cork to meet the claimed "compound hidden image" of these specific claims. Any claimed limitations not specifically discussed herein are clearly shown in Cork.

Regarding the amendatory language to claims 36 and 41 to "randomly displaying...compound hidden image", this language is met by Cork in the

display of the video of the soccer ball leading up to the freezing of the image and hiding of the image for play of the game.

Regarding the amendatory language to claims 36, 41, 52 and 55, Cork fails to show levels in the game where inputs are received and their success evaluated prior to the acceptance of additional inputs. However, Moza clearly suggests a game comprising multiple rounds or levels such that a player makes an input, a reveal is made, and player makes an input, a reveal is made, and so on. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the game of Cork to include multiple rounds or levels such that a player makes an input, a reveal is made, and player makes an input, a reveal is made, and so on, in order to provide an attractive, interesting, and challenging game for a player as desirably suggested by Moza.

The difference between claims 37, 38, 57 and 58 and Cork in view of Moza lie in the recitation of plural hidden patterns, while Cork only clearly show/discusses one ball being hidden. However, the provision of multiple targets in the Cork game only serves to enhance the gaming experience and would further attract players. Furthermore, an image could be generated showing multiple players practicing their soccer “dribbling”, giving a player multiple targets to attempt and increasing their odds of winning. The provision of such would allow game designers to have greater control over the overall payout of the game machine – a necessary requirement for implementation in regulated gaming areas such as the United States. Therefore it would have

been obvious to one of ordinary skill in the art at the time of the invention to modify the game illustrated in Cork as modified by Moza to include a plurality of hidden target patterns for a player to attempt to find in order to provide an attractive bonus game for players while meeting payout control regulations so that the game may be deployed on the gaming room floor.

The difference between Cork in view of Moza and instant claims 39 and 42 lies in recitation of a progressive jackpot payout. The combination fails to include a jackpot payout – a special award, for example, if a player makes a selection that is perfectly center of the hidden image. However, use of progressive jackpot payouts to attract players and increase play is notoriously well known. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the game illustrated in Cork in view of Moza to include a progressive jackpot payout for a perfect target hit, in order to attract more players to the game.

Claims 40 and 43 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cork in view of Moza as applied to claims 36 and 42 above, and further in view of Trend (GB 2105560).

Cork in view of Moza fails to explicitly teach a free game as a possible award in his spot-the-ball game. Trend discloses an analogous spot-the-ball game, and clearly discloses a free game as an award in col1 lines 35 – 40. As awards are within the purview of game designers and are selected based upon design criteria, absent any unexpected advantage it would have been obvious

to one of ordinary skill in the art at the time of the invention to modify the game illustrated in Cork in view of Moza to include a free game award based upon appropriate criteria as such are commonly known as illustrated by Trend. Absent any unexpected advantage, provision of one type of award over another type of award does not serve to define patentability.

### ***Response to Arguments***

Applicant's arguments with respect to claims 36 - 58 have been considered but are moot in view of the new ground(s) of rejection. To the extent that the presented arguments remain relevant the examiner offers the following rebuttal.

Regarding the rejection under 35 USC 112 2<sup>nd</sup> paragraph, applicants comment that both types of games are disclosed are noted with appreciation. However, the examiner has not asserted a lack of antecedent for the terminology in the specification. Rather, the claim itself is confusing in that only a casino game is defined throughout and in the last line a casino bonus game is referred to. Applicant is referring to something not positively defined in the claim.

Next, applicant disagrees with the characterization of Cork as a strategy based game and urges that it is dependent upon luck, not strategy. In response, the examiner notes that no structure is seen in applicants claim to give any particular meaning to "strategy based" game. No steps of strategy are



defined nor is any language seen that would add force to the language. Nor has applicant pointed to any particular passage of specification in the instant application that would give any particular definition of what is encompassed by the language "strategy based game." Notwithstanding, the examiner has outlined above specific teachings that define 'spot the ball' games such as relied upon in the rejection as being strategy or skill based and not based upon random luck as argued by applicant. In sum, it is submitted by the examiner that the prior art applied is indeed a strategy-based game in as much as it is at least as strategy-based as applicant's game is strategy-based.

Likewise, in a similar analysis, it is submitted that the examiners proposal of a soccer ball (European football) is as much of a "compound pattern" as applicant has defined a compound pattern, and the prior art's teaching of the pattern being "blanked out" or "the depicted image does not include the ball" provides as hidden an image as that claimed. The attract mode shows the nature of the game (random display of image with ball prior to coin insertion) and then the compound image of the ball is "hidden". The fact that the word "hidden" is not used does not detract from the identical meaning and function being fully present. Further, applicant's arguments that Cork does not provide a plurality of balls as related to claims 37, 38, 57 and 58 are not persuasive in that such remarks are not commensurate in scope with the claimed language. Applicants comments with respect to the "spot the ball" characterization are not well taken. See Trend page 1 lines 1-2, 21,33-34, at

least. As this game is substantially similar to that described in Cork, the examiner is of the opinion that it is more than fair to characterize both games as 'spot the ball' games in as much as applicant characterizes his game as both a casino game and a casino bonus game. No casino is claimed. No wager inputs are claimed. No bonus is paid out in applicant's claims. Yet applicant entitles his games thusly.

### ***Conclusion***

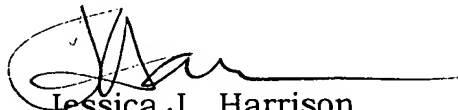
Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jessica J. Harrison whose telephone number is 703-308-2217. The examiner can normally be reached on 8 hour/M-F.

The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0858.

  
Jessica J. Harrison  
Primary Examiner  
Art Unit 3714

jjh